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DEPT. NLEG BLDG H-1  
LAKE FOREST IL 60045-2579

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**OFFICE OF PETITIONS**

In re Application of :  
Silkaitis, et al. :  
Application No. 10/783,640 :  
Filing Date: 5 May, 2003 :  
Attorney Docket No. 7135US03 :  
:

DECISION

This is a decision on the renewed petition filed on 30 May and resubmitted on 31 May 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, alternatively to revive alleging unintentional delay under 37 C.F.R. §1.138(b).

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; and the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner Michael Crabb (Reg. No. 37,298) failed to reply timely and properly to a Notice of Missing Parts mailed on 13 May, 2004, with a reply due, absent extension of time, on or before 13 July, 2004;
- the application went abandoned after midnight 13 July, 2004;
- Notice of Abandonment was mailed on 9 February, 2005;

- Petitioner filed the instant petition on 14 April, 2005, and argued there that he had not received the Notice of Missing Parts and that he had examined his files and his docket and no such document and/or notation thereof was in evidence;
- however, the record is clear that:
  - the Notice of Missing Parts properly was mailed to the then-address of record, to wit: Steven F. Weinstock, Abbott Laboratories, 100 Abbott Park Road, Dept. 377/AP6A, Abbott Park, IL 60064-6008;
  - as of 14 April, 2005, and the filing of the instant petition—which indicates no mailing address but rather a Customer Number 41155 set forth at the end of the paper and which number apparently is associated with the address set forth at the top of this paper, to wit: Brian R. Woodworth, 275 N. Field Drive, Dept. Nleg Bldg H-1, Lake Forest IL 60045-2579—Petitioner had not noticed the Office of a change of address; and
  - moreover, Petitioner did not so notice the Office of a change of address until 3 August, 2005, at which time Petitioner filed a Revocation/Power of Attorney; and

accordingly, the 30 January, 2006, petition was dismissed on 30 May, 2006, for failing to satisfy the burden of proof;

- the renewed petition traces an extensive history of the corporate creation, spinoff and merger, transfer of assets (including interests in the instant application) and associated support activities provided by Petitioner and his colleagues—including efforts to obtain a new customer number—however, the fundamental failure of proof as to the burden to obtain withdrawal of the holding of abandonment is that: no Notice of Change of Address was filed in the instant application before the mailing of the Notice of Missing Parts, such that the mailing in question was directed to the address of record as of that mailing and, thereafter, no timely and proper reply was filed to the Notice of Missing Parts mailed in the instant application on 13 May, 2004;
- in addition to seeking to re-advance the request to withdraw the holding of abandonment, Petitioner also filed a petition under 37 C.F.R. §1.137(b), with fee, and reply in the form of the oath/declaration and fee/surcharge and made a statement of unintentional delay—thus, Petitioner appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b).

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>)

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the requirements for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

As the history set forth in the Background, above, clearly indicates, Petitioner has not satisfied these requirements.

Allegations as to  
Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

It appears that Petitioner has satisfied the requirements of the regulation.

CONCLUSION

Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, and the petition as considered under 37 C.F.R. §1.181 hereby is dismissed; however, Petitioner appears to have satisfied the regulatory requirements, the petition under 37 C.F.R. §1.137(b) is granted.

The application is released to OIPE for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).